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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92024108
Party	Plaintiff Galleon S.A., Bacardi-Martini U.S.A. and Bacardi & Company Limited
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Submission	Response to Board Order/Inquiry
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GALLEON S.A.,
BACARDI-MARTINI U.S.A., INC., and
BACARDI & COMPANY LIMITED,
Petitioners,

-against-

HAVANA CLUB HOLDINGS, S.A. and
EMPRESA CUBANA EXPORTADORA
DE ALIMENTOS Y PRODUCTOS
VARIOS, S.A. D/B/A CUBAEXPORT,
Respondents.

Cancellation No. 92/024,108

RESPONSE TO DECEMBER 15, 2011 ORDER


Petitioners submit this response to the Board's December 15, 2011 order. Civil Action No. 1:04-CV-00519 (the "Civil Action") remains pending in the United States District Court for the District of Columbia. On August 4, 2008, the United States District Court for the District of Columbia entered an order staying further proceedings in the Civil Action pending appeal of the USPTO's August 3, 2006 order canceling Reg. No. 1,031,651 for the mark HAVANA CLUB (the "Cancellation Order"). Accordingly, there has been no final resolution of the Civil Action, and this proceeding should remain suspended.

An appeal relating to the Cancellation Order was brought before the United States District Court for the District of Columbia under the name *Empresa Cubana Exportadora de Alimentos y Productos Varios v. United States Dep't of the Treasury, et al.* On March 30, 2009, the District Court issued an order granting Defendants' motions to dismiss or for summary judgment. On March 29, 2011, the Court of Appeals for the D.C. Circuit issued an opinion and judgment affirming the District Court's judgment. On August 31, 2011, petitions for rehearing

and rehearing *en banc* were denied. On October 27, 2011, the Supreme Court granted an extension of time to file a petition for certiorari, and any petition for certiorari must be filed by January 28, 2012.

Dated: New York, New York
December 16, 2011

KELLEY DRYE & WARREN LLP
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing RESPONSE TO DECEMBER 15, 2011 ORDER has been served upon registrant's attorney, Herbert Schwartz, Fish & Neave IP Group, Ropes & Gray LLP, 1211 Avenue of the Americas, New York NY 10036, the address designated by said attorney for that purpose by depositing a true copy thereof with the United States Postal Service as first-class mail on December 16, 2011

Dated: December 16, 2011



Matthew D. Marcotte

CERTIFICATE OF FILING

The undersigned hereby certifies that the foregoing RESPONSE TO DECEMBER 15, 2011 ORDER has been filed electronically with the United States Patent and Trademark Office.

New York, New York
December 16, 2011



Matthew D. Marcotte